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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,575	09/17/2003	Jonathan Fanger	101896-0208	3611
21125	7590	12/27/2007	EXAMINER	
NUTTER MCCLENNEN & FISH LLP WORLD TRADE CENTER WEST 155 SEAPORT BOULEVARD BOSTON, MA 02210-2604				SWIGER III, JAMES L
ART UNIT	PAPER NUMBER		3733	
NOTIFICATION DATE	DELIVERY MODE		12/27/2007	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docket@nutter.com

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/664,575	FANGER ET AL.
	Examiner James L. Swiger	Art Unit 3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 01 October 2007.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,3,7,11,12,16-19,25-28,33,34 and 52-63 is/are pending in the application.
  - 4a) Of the above claim(s) 11,12 and 26 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,3,7,16-19,25,27,28,33,34 and 52-63 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 3/3/2006 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

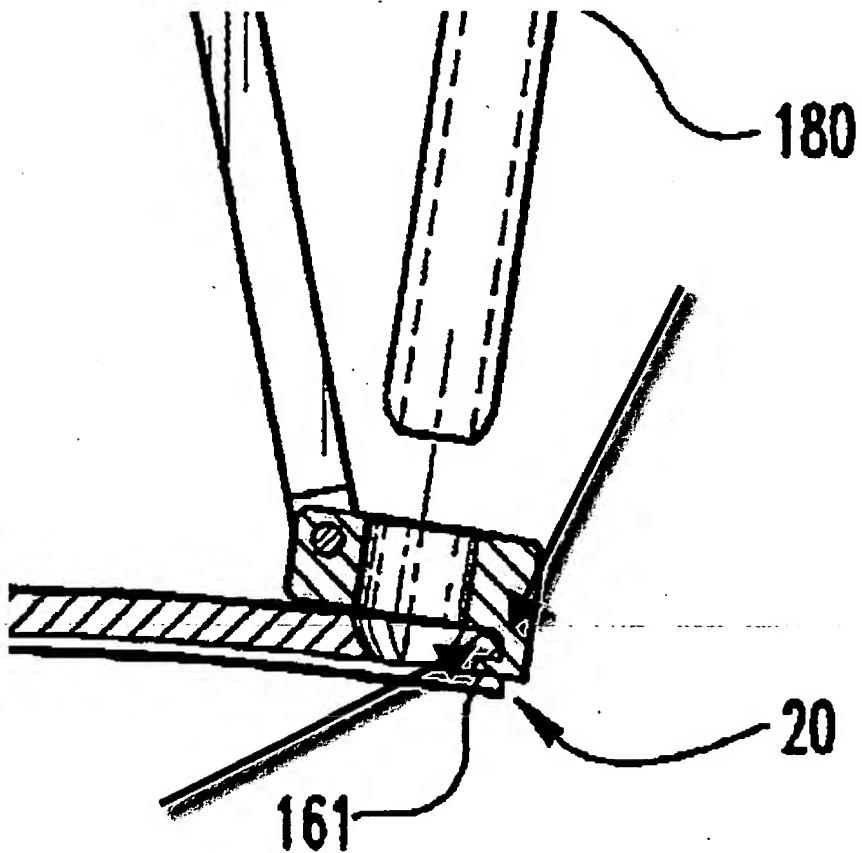
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 7, 16-19, 25, 27-28, 33, and 52-63 rejected under 35 U.S.C. 102(b) as being anticipated by Coates et al. (US Patent 5,423,826). Coates et al. disclose a guide device for guiding a drill and/or plate comprising an elongate shaft (See Fig. 14, elongate central portion that splits) that has a proximal and distal end and a varying width, a guide member (157) attached to the distal end of the shaft that also includes two lumens (158, on both sides, wherein the guide member at the distal end is considered one unit), opposing alignment tabs (161), and also wherein the lumens (158) are between the alignment tabs, and wherein the tabs and guide device are capable of non-fixedly attaching to a plate and also wherein they align with a corresponding hole in the plate (see paragraph 2, see lines 35-43).

It is further noted that in regard the alignment tabs, it is considered a functional limitation how they interact with the plate, which is not positively recited itself. The tabs are "adapted to interact" and they are fully capable of doing so as the claim requires with the functional limitation. Additionally, with regards to the claim amendments, it is not clear how a tab could *fixedly interact* and do so *without engaging the spinal plate*.

This seems counterintuitive. Aside, it is still a functional limitation so it is not considered a positive structural limitation.

The alignment tabs are also considered to have concave inner surfaces. As noted above adapting with a plate is function. However, *arguendo*, the tabs still have a concave portion and would fix to a corresponding portion of the convex plate (see enlarged drawing below).



The lumens are also positioned with respect to one another (Col. 2, lines 30-40), and wherein the barrels (180) to aid in guidance are angled with respect to one another (see fig. 19) through the lumens (158).

***Response to Arguments***

Applicant's arguments with respect to the pending claims have been considered but are not considered persuasive. Further clarifications have been added to the rejection as noted above in response to the arguments and claim amendments. As stated above, it is further noted that in regard the alignment tabs, it is considered a functional limitation how they interact with the plate, which is not positively recited itself. The tabs are "adapted to interact" and they are fully capable of doing so as the claim requires with the functional limitation. Additionally, with regards to the claim amendments, it is not clear how a tab could *fixedly interact* and do so *without engaging the spinal plate*. This seems counterintuitive. Aside, it is still a functional limitation so it is not considered a positive structural limitation. Applicant is reminded that it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James L. Swiger whose telephone number is 571-272-5557. The examiner can normally be reached on Monday through Friday, 9:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*JS 12/11/07*  
EDUARDO ROBERT  
SUPERVISOR  
EXAMINER